

**REMARKS/ARGUMENTS**

The present application was originally filed with claims 1-52. By prior Amendments, the Applicant canceled claims 1-52, without prejudice or disclaimer, added new claims 53-90, and withdrew claims 72-90. By the present Amendment, independent claim 53 is amended, as are dependent claims 54, 56-59 and 63. Accordingly, claims 53-71, as herein amended, are presently under review, and reconsideration of these claims is respectfully requested.

**I. REJECTIONS UNDER 35 U.S.C. §112**

The Examiner has rejected claims 53-71 under 35 U.S.C. §112, first paragraph, as allegedly reciting new matter based on claim amendments made in the prior Amendment. While the Applicant do not necessarily agree with this assertion, independent claim 53 have been amended to recite that the first and second "incentives" are provided by the first and second virtual documents, respectively. While the "virtual documents" disclosed in the present application are sent to the consumer(s) to allow him to take advantage of the incentive, the original financial or other type of incentive is created and honored by an advertiser. Thus, the virtual documents are virtual embodiments of the incentives provided by the advertisers and redeemed via merchants, etc. Based on the above, it is believed the present amendment clear up any confusion on this point, and thus that this rejection has been overcome.

The Examiner has also rejected claims 53-71 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for using the terms "first distribution partner/first advertiser" and "second distribution partner/second advertiser." Specifically, the Examiner appears to regard the use of these terms as improper based on an interpretation that the distinction between partners and advertisers is only based on "ownership."

Initially, the Applicant notes that independent claim 53 has been amended to expressly recite that the first virtual document includes:

data identifying a first incentive offer that is provided by the first virtual document, data identifying a first distribution partner that is unassociated with the network database but distributed the first incentive offer, and data identifying a first business advertiser that is unassociated with the network database but is associated with the first received virtual document and the first incentive offer;...

and that the second virtual document includes:

data identifying a second incentive offer that is provided by the second virtual document, data identifying a second distribution partner that is unassociated with the network database but distributed the second incentive offer, and data identifying a second business advertiser that is unassociated with the network database but is associated with the second received virtual document and the second incentive offer;...

As a result, the present claims expressly recites receiving virtual documents having data representing the identity of certain parties, rather than directly reciting those parties.

In addition, independent claim 53 has been amended to recite first data fields in a consumer's data record on the database that include "the data identifying the first incentive offer, the data identifying the first distribution partner, and the data identifying the first business advertiser," and second data fields in the consumer's data record that include "the data identifying the second incentive offer, the data identifying the second distribution partner, and the data identifying the second business advertiser." As a result, the present claims expressly recite the storing of data found in the virtual documents identifying certain parties, rather than directly reciting the parties.

Further on this point, the Examiner has again posed the question of how the validity of a patent issued on the present claims would be impacted if, for example, first and second business

advertisers merged and became the same entity, and/or if that single entity later split. The Examiner also continues along these lines with other potential scenarios involving the organizational status of one or more "business advertisers" as that term is recited in the claims. To the best of the Applicant's knowledge, there has never been a situation where a patented claim's validity turned on the organizational status of an accused infringer. Indeed, if a claim required distinct first and second business advertisers, and accused infringers were actually the same advertiser, then it would seem simply that the accused infringer(s) would have an argument of non-infringement of that claim. There could not be, under any circumstance of which the Applicant is aware, a claim of invalidity based solely on the status of the defendants as a single entity or as two distinct entities. Along these lines, the Examiner has cited two Supreme Court cases, one modern and one from 1819. However, these cases do not concern or invoke patent law, and the cited portions merely discuss the existence of corporations only by operation of law. However, no citation to any law or precedent is provided in the current Office Action that would support the Examiner's belief that the change in organizational status of an accused infringer has any bearing on the validity of the asserted patent, much less invalidate that patent. In view of the above, the Applicant respectfully requests a citation to any precedent where a patent claim was held invalid merely by the accused infringer merging with, or dividing to create, another entity, co-defendant or not.

The Examiner has also cited M.P.E.P. 2106.II.A in support of this assertion. However, this section of the M.P.E.P. exclusively concerns whether the written description of an application provides sufficient description of a utility of an invention. In the present case, there can be no doubt either that the claimed invention(s) is/are useful, or that the present specification

conveys such usefulness. A method of managing virtual documents for a consumer in the manner recited in the present claims provides a useful process for organizing virtual documents that convey to specific consumers certain incentive offers offered by advertisers, when those virtual documents are transmitted to a database by someone other than that advertiser. Such claims are no less valid or less useful if an advertiser is also the sender of the virtual document. That defendant would instead simply argue non-infringement of the claims, but that would have no bearing of whether other defendants may infringe the present claims.

For at least the above reasons and in view of the above-mentioned claim amendments, the Applicant respectfully asserts that the present claims are not definite. Accordingly, the Applicant requests that the Examiner withdraw this §112 rejection with respect to the present claims.

The Examiner has also rejected claims 53-71 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for reciting the phrase "unassociated with the network database." In response, the Applicant has amended claim 53 to ensure clarity with who is "unassociated with the network database." Accordingly, it is believed this ground of rejection of the present claims has also been overcome.

## **II. REJECTIONS UNDER 35 U.S.C. §103**

The Examiner has rejected claims 53-71 under 35 U.S.C. §103(a) as allegedly obvious in view of U.S. Patent No. 6,915,271 to Meyer *et al.* In response, the Applicant has amended independent claim 53 to be distinguishable from Meyer. Thus, the Applicant respectfully asserts that Meyer does not teach or suggest all of the elements of independent claim 53, and its dependent claims, as herein amended.

Specifically, with reference to amended independent claim 53, Meyer does not disclose receiving a first virtual document having:

data identifying a first incentive offer that is provided by the first virtual document, data identifying a first distribution partner that is unassociated with the network database but distributed the first incentive offer, and data identifying a first business advertiser that is unassociated with the network database but is associated with the first received virtual document and the first incentive offer;...

In addition, Meyer does not disclose receiving a second virtual document having:

data identifying a second incentive offer that is provided by the second virtual document, data identifying a second distribution partner that is unassociated with the network database but distributed the second incentive offer, and data identifying a second business advertiser that is unassociated with the network database but is associated with the second received virtual document and the second incentive offer;...

In contrast, Meyer provides a wholly enclosed and private system and method where incentives reside on an incentive database 107, and where information regarding consumers and their selected incentives resides on a member database 11. *See* Fig. 1 of Meyer; col. 6, lns. 44-50; col. 10, ln. 43, to col. 11, ln. 40. The private system therefore creates the incentives, then places the incentives on a network for potential consumers to find, and once selected by a consumer, the selective incentives are associated with the consumer's membership information stored on the member database within the same private system. As a result, the incentives are created in Meyer's private system, the incentives are placed in the network by the private system, selected incentives are associated with consumers by the private system, and the consumer's information and selected incentives are stored by and within the private system. Therefore, in contrast to the express requirements of amended claim 53, Meyer does not teach or suggest the receiving of first and second virtual documents having the specific data recited above included in the documents.

In addition, as discussed above, claim 53 has also been amended to recite storing information in first data fields in a consumer's data record on the database that includes "the data identifying the first incentive offer, the data identifying the first distribution partner, and the data identifying the first business advertiser," as well as storing information in second data fields in the consumer's data record that includes "the data identifying the second incentive offer, the data identifying the second distribution partner, and the data identifying the second business advertiser." In contrast, Meyer does not teach or suggest the storing of the type of data expressly require by claim 53, as amended. Since Meyer only teaches that the creation, distribution, selection and storing of incentives are to be provided by the same private system that consumers join, Meyer cannot teach the storing of the identification data recited in the present claims. A beneficial result provided by the storing of the specific information and data recited in the present claims is that only the consumers are associated with the database storing the selected virtual documents, while the creators and distributors of the incentives need not have any association with the consumer database. The data provided in the virtual documents identifies the creators and distributors of the incentives as instead being associated with the single document source, which transmits the virtual documents to the consumer database once a consumer's selection is made. However, Meyer does not teach or suggest the storing of such data from the virtual documents, and therefore cannot provide this feature of the present claims.

For at least the above reasons, Meyer does not teach or suggest all of the elements recited in independent claim 53, as herein amended. Thus, Meyer does not render obvious claim 53 or the claims dependent on this claim. Accordingly, the Applicant respectfully requests that the Examiner withdraw the rejection of the present claims.

### III. CONCLUSION

The Applicant submits that claims 53-71 are allowable, and therefore a Notice of Allowability is respectfully requested. The Examiner is requested to contact the Attorney of Record in needed to expedite prosecution of the present application, or to discuss any of the above arguments in further detail.

The three-month period for response expires on February 14, 2009; however, this date falls on a Saturday. In addition, the following Monday, February 16, 2009, is a federal holiday (President's Day). Thus, the three-month response period expires on Tuesday, February 17, 2009, and therefore this Amendment is timely filed. Also, since the pending Office Action is a final action, the present Amendment is being filed with a Request for Continued Examination, along with the required fee. If any other fees are believed to be due with this filing, the Director is hereby authorized to charge Deposit Account No. 13-0480 for any such fees, referencing the Attorney Docket Number specified herein.

Respectfully submitted,

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